



Practitioner's Docket No.: 8009-7004-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the Application of: Elizabeth Shanahan-Prendergast

RECEIVED

Ser. No.: 09/254,623

Art Unit: 1642

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Filed: July 8, 1999

Examiner: Davis, M. TECH CENTER 1600/2900

For: Therapeutic Formulations Containing Venom or Venom Anti-Serum Either Alone or in Combination for the Therapeutic Prophylaxis and Therapy of Neoplasms

Assistant Commissioner For Patents
Washington, D.C. 20231

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 addressed to Assistant Commissioner for Patents, Washington D.C. 20231 on June 19, 2001 under "EXPRESS MAIL" mailing label number EL 803163795 US.

Gina M. Husak

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

Sir:

In response to the Office Action mailed December 19, 2000, the applicant hereby provisionally elects Group V, claims 5, 45 and 46, with traverse. It is respectfully submitted that claims 43, 44 and 57, which depend from claim 5 (and therefore cannot be said to be "independent" and distinct relative to the subject matter of claim 5, should be examined in the present application, in order to conserve U.S. Patent and Trademark Office resources, and because doing so would not place an undue burden on the Examiner. In addition, the subject matter of Groups XXI, XXXIV, XXXVII, XXXXVI and XXXXXXXX is sufficiently related to that of Group V that there would not be an undue burden on the U.S. Patent and Trademark Office to search and examine these claims and the claims which depend from them. According to the MPEP (section 803), if the search and examination of an entire application

can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. It is respectfully submitted that the subject matter of all of these claims is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. Thus it is respectfully submitted that the search and examination of the entire application could be made without serious burden. It is respectfully submitted that this policy should apply in the present application to avoid unnecessary delay and expense to the applicants and duplicative examination by the USPTO.

35 U.S.C. 121 states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. The MPEP defines the term "independent" (i.e., not dependent) as meaning that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect.

In addition, the present application was filed under 35 U.S.C. 371. During the international stage, PCT Rules 13.1 and 13.2 were applied, and it was found that there exists unity of invention among all of the subject matter of the claims pending during the international stage. As stated in the MPEP, § 1893.03[d], when the Patent and Trademark Office considers international applications during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 are followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. Likewise, MPEP § 1898.08(a) states "[t]he unity of invention practice set forth in PCT Rule 13 will be applied in national stage application under 35 U.S.C. 371 because 35 U.S.C. 372(b)(2) provides that, 'The Commissioner may cause the question of unity of invention to be reexamined under section 121 of this title, within the

scope of the requirements of the treaty and the Regulations.' “

In ANNEX B, PART 2 of the Manual of Patent Examining Procedure, there are provided examples which illustrate principles of unity of invention. An example of a relevant example is Example 13 (MPEP, page AI-45), in which it is stated that unity of invention exists among claims of the same category, in which a special technical feature is common to the claims, even though there exists a combination-sub-combination relationship.

Furthermore, it is respectfully noted that an applicant has a right to have each claim examined on the merits. A single claim that is required to be divided up and presented in several applications would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be equivalent to the original claim. In re Weber, Soder, and Boksay 198 USPQ 328 (CCPA 1978). Regardless of the language employed by an Examiner, a refusal to examine a claim is, in effect, a rejection. Ex parte Holt and Randell, 214 USPQ 381 hn2 (USPTO Board of Appeals 1982). The only justification or statutory authority put forth for refusing to examine is 35 USC § 121. There is nothing therein to excuse a refusal to examine an elected invention or an applicant's generic (broad) claim reading thereon, notwithstanding the generic claim reads on non-elected inventions and possibly many others, all potentially separately patentable. 198 USPQ at 333.

Of the claims within the elected group (Group V), claims 5, 45 and 46 read on the elected species.

In the event that there are any questions or concerns regarding this paper or the attachments to this paper, the appropriate USPTO representative is invited to telephone the undersigned at the number listed below.

Submitted herewith is a Petition for Extension of Time, together with a check to cover a five-month extension of time. Should any additional fees be due with respect to this paper,

the Commissioner is hereby respectfully requested and authorized to charge such fees to Counsel's Deposit Account No. 50-1446. Should any refund be due to applicants, it is respectfully requested that such refund be credited to Counsel's Deposit Account No. 50-1446.

Respectfully submitted,
BURR & BROWN

June 19, 2001

Date

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